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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,775	02/15/2001	John Wankmueller	AP33001-070457.0972	2264
21003	7590	02/27/2006		
BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER KESACK, DANIEL	
			ART UNIT	PAPER NUMBER
			3624	
DATE MAILED: 02/27/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,775

Applicant(s)

WANKMUELLER, JOHN

Examiner

Dan Kesack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/30/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. The following Office Action is in response to the Amendment filed December 30, 2005. Claims 1-10 are pending in the application. The rejection of claims 2, 4, 5, 9, and 10 under 35 U.S.C. 103(a) as being unpatentable over Paltenghe (2002/0004793) in view of Chaum (6,434,238) is herein repeated and made final. Applicant's arguments have been fully considered but they are not persuasive.

Regarding Applicant's arguments against the previously stated rejections of claims 2, 4, 5, 7, 9, and 10, Examiner respectfully disagrees. Chaum teaches cryptographic security methods used in financial transactions involving smart cards. Further, Chaum teaches the disclosed device being used in a transaction comprising sending messages between a terminal receiving the smart card, and a server (column 15 lines 21-50). Therefore, Chaum provides sufficient motivation to modify the teachings of Paltenghe to include the security features of Chaum.

Claim Rejections - 35 USC § 102

2. Claims 1 and 3 remain rejected under 35 U.S.C. 102(e) as being anticipated by Paltenghe, U.S. Patent Application Publication No. 2002/0004783. Paltenghe discloses

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a visual wallet system including methods and systems of information and financial banking methods utilizing such wallets. Paltenghe teaches a wallet server receiving a signed receipt from the consumer computer, along with a selected payment mechanism, and the wallet server intermediating the payment transaction by sending payment information and authorizations to the merchant server. The server conducts the transaction with the merchant server on behalf of the consumer. Paltenghe further teaches the system uses chip cards along with the wallet server and the merchant server to complete the transaction (See page 6-7, paragraph 71). Paltenghe also teaches a virtual wallet system using non-chip protocols such as Visa credit card, MasterCard credit card etc, as well as chip card compliant technologies such as MasterCard and Visa SET certificates (paragraph 97).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 2, 4-10 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe in view of Chaum, U.S. Patent No. 6,434,238.

Paltenghe fails to teach the generation of a cryptogram by the remote wallet server based on secret data shared between the remote wallet server and the issuer institution.

Chaum discloses a multipurpose transaction card system. Chaum teaches the system may be implemented with chip cards or EMV cards, in order to securely transfer data related to financial transactions. Chaum teaches the system where the card issued by an issuing institution communicates with servers which hold account information, the servers containing tamper resistant memory devices which hold secret keys shared between the card and the server for use in secure cryptographic transmission of data (See column 3 lines 41 thru 52). Chaum further teaches the tamper resistant device containing the means for performing authentication of said cryptogram (column 31 lines 37 thru 40). It would have been obvious for one of ordinary skill in the art at the time of the invention to include the cryptographic shared key authentication techniques disclosed in Chaum in the wallet server method disclosed in Paltenghe in order to securely transfer data between servers, as secure transmission is a desirable characteristic of any electronic financial transaction.

6. Claims 1, 3, 6, 8, In response to applicant's arguments, the recitation "wherein the payment card is either issued by an issuer institution having infrastructure to support chip card transactions or issued by an issuer institution having legacy infrastructure supporting only non-chip card transactions" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hira*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

7. Claims 1, 3, 6, 8, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., dual use with both chip payment and non-chip payment cards, seamless integration of legacy and new payment technologies) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Specifically, the recitation of claims 1, 3, 6, and 8 that the "transaction is accomplished when the payment card is either issued by an issuer institution having infrastructure to support chip card transactions or issued by an issuer institution having legacy infrastructure supporting only non-chip card transactions" (Emphasis added).

The claim does not recite dual use, but rather recites limitations in the alternative, requiring only one of the two described infrastructures in order to meet the claim.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

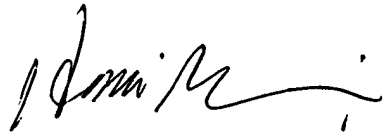
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HANI M. KAZIMI
PRIMARY EXAMINER